

REMARKS/ARGUMENTS

Claims 1-23 are currently pending. Claims 1, 4, 7, 8, 14, 17 and 18 have been amended. Claims 21 -23 have been added. No new matter has been added with the amendment. Reconsideration of this Application and entry of this Amendment after Final are respectfully requested. The proposed amendment places the claims in better form for appeal. Additionally, this amendment addresses items brought up by the examiner in the final office action. In view of the amendments and following remarks, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. §102 Rejections

The Examiner's rejection of claims 1-6 and 17-20 under 35 U.S.C. 102(b) as being anticipated by Buirge is traversed. At a minimum, Buirge does not disclose:

- 1) a stent delivery system including a stent disposed on a balloon and a coating disposed on an outer surface of the stent, the coating applied to a preliminary stent comprising a permanent portion and a detachable portion while retaining the preliminary stent by the detachable portion, the stent formed from the permanent portion by removing the detachable portion with a pooled coating, as recited in independent claim 1; and
- 2) a system for producing a stent including means for providing a preliminary stent comprising a permanent portion and a detachable portion, means for retaining the preliminary stent by the detachable portion, means for applying a coating to an outer surface of the preliminary stent and means for detaching the detachable portion with a pooled coating from the permanent portion, as recited in independent claim 17.

Specifically, Buirge does not teach coating an outer surface of a stent or means for applying a coating to an outer surface of a stent as claimed and described by the Applicant (see Specification page 5 lines 3-16). At most, Buirge discloses forming a three layer long tube using a dip process, cutting the long tube into separate stent pumps, and dipping the ends to seal the intermediate layer containing the therapeutic agent

(Buirge, col. 4, lines 32 – 52). In fact, nowhere within the Buirge patent does Buirge disclose coating an outer surface of a stent or any other device as claimed by the Applicant (see col. 5 lines 34-47). Withdrawal of the rejection of claims 1-6 and 17-20 under 35 USC 102(b) is respectfully requested.

35 U.S.C. §103 Rejections

The Examiner's rejection of claims 7-16 under 35 U.S.C. 103(a) as being unpatentable over Buirge in view of admissions in the present specification is traversed because the Examiner has failed to establish a *prima facie* case of obviousness as required by MPEP §2143.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, MPEP §2143.

There is no teaching or suggestion within Buirge in view of the present specification to lead one of skill in the art to arrive at the invention as claimed. In fact, Buirge teaches away from the invention in teaching that the individual coated and cured stent pump is removed from the forming mandrel (Buirge col. 4, lines 43 – 57), without the need to remove the stent pump from a coated detachable portion with a pooled coating as required by the present claims.

Buirge also teaches away in that it discloses that rigid layer 16 provides structural integrity and acts as a stent (Buirge, col. 3, lines 39-41). As such, the dipping process to form the long tube with layers 12, 14 and 16 and then subsequently cutting the long tube, is the process of forming individual stent pumps, not the process of coating an individual stent as required by the present invention.

Additionally, Buirge does not teach or suggest, alone or in combination with the alleged admissions, coating an outer layer of the stent as required by claim 7. At most, Buirge teaches the coating of the ends of individual stent pumps after the stent pumps

have been removed from the forming mandrel to seal the ends of the intermediate layer

14. For at least these reasons, the withdrawal of the rejection of claims 7-16 under 35 U.S.C. 103(a) is requested.

New claims 21 to 23

New claims 21 -22 depend from claims 1 or 4 and are patentable over the cited art for at least the same reason as states above for claims 1 and 4. Claim 23 is an independent claim. Support for the new claims 21 and 22 can be found at least on page 7 lines 23 to 27. Support for new claim 23 can be found at least on page 6 line 3 to page 7 line 27 and FIG. 2. No new matter has been added with this amendment.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

/Alan M. Krubiner, Reg. No. 26,289/

Alan M. Krubiner
Registration No. 26,289
Attorney for Applicant

Medtronic Vascular, Inc.
3576 Unocal Place
Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420